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EXAMINER	
WINTER, JOHN M	
ART UNIT	PAPER NUMBER
3685	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/770,353	KRISHNAN ET AL.	
	Examiner	Art Unit	
	JOHN M. WINTER	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *65-74 and 83-143* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *65-74 and 83-143* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/23/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. The Applicants papers filed on December 15, 2010 is hereby acknowledged. Claims 65-74 and 83-143 remain pending

Response to Arguments

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 65-74 and 83-143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (US Patent No 5,708,709) in view of Coley et al. (US Patent 5,790,664).

3. As per claims 65 and 71,

Rose ('709) discloses a computer-readable storage medium with an executable program stored thereon, wherein the program instructs a client computer to perform steps enabling licensing of digital content, comprising:

communicating with a licensing broker to obtain a licensing certificate to at least the portion of the digital content; (Figure 9A; Column 7, lines 26-67).

Rose ('709) does not explicitly disclose storing at least a portion of the digital content in an unusable form on the client computer; and in response to the obtained licensing certificate, generating a useable form of at least the portion of the digital content from the stored unusable form. Coley et al. ('664) discloses storing at least a portion of the digital content in an unusable form on the client computer; and in response to the obtained licensing certificate, generating a useable form of at least the portion of the digital content from the stored unusable form. (Figure 2; Column 4, lines 41-48; column 9, lines 1-23; column 9, lines 42-51; Column 14, lines 57-67). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rose ('709)'s teaching with the Coley et al. ('664) method in order to enable licensed usage of a digital product. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language

that suggest or makes optional but does not require steps to be performed (e.g. in response to …) or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

4. As per claim 66,

Rose ('709) discloses the computer-readable storage medium of claim 65,

wherein the steps further comprise: receiving the digital content on the client computer.(Figure 8)

5. As per claims 67 and 72,

Rose ('709) discloses the computer-readable storage medium of claim 65,

wherein the steps further comprise: presenting a selection interface on the client computer which provides a description of the digital content to enable acquisition of the digital content, that is then stored on the client computer, from a digital content vendor. (Figure 2, Column 3, lines 35-47)

6. As per claims 68 and 73,

Rose ('709) discloses the computer-readable storage medium of claim 67, wherein the steps further comprise:

generating a digital-content-accessing component on the client computer from the digital content, and wherein the digital-content-accessing component is an executable file

configured to: access and receive additional digital content from a remote computer system. (Column 3, lines 47-60; Column 8, lines 28-31).

7. As per claims 69 and 74,

Rose ('709) discloses the computer-readable storage medium of claim 68, wherein the steps further comprise:

generating a message digest from the generated digital-content-accessing component; and comparing the generated message digest with a stored message digest to enable verification of the digital content. (Column 10, lines 30-42).

8. As per claims 70,

Rose ('709) discloses the computer-readable storage medium of claim 65,

wherein the licensing broker is a remote licensing broker. (Figure 9A; Column 3, lines 35-47)

9. As per claims 83,

Rose ('709) discloses the method of claim 71, further comprising:

receiving the digital content on the client computer, wherein the communicating with the licensing broker is coordinated from a license component that is incorporated within the received digital content.(Column 5, lines 19-42)

10. As per claims 84,

Rose ('709) discloses the computer-readable storage medium of claim 66, wherein the communicating with the licensing broker is coordinated from a license component that is incorporated within the received digital content. (Column 7, lines 8-26)

11. As per claims 85, 99, 113, 122, 128, 132 and 135,

Rose ('709) discloses a method for acquiring digital content, comprising: communicating, by a license component executing on the computing device, with a remote licensing broker to request a license certificate to the digital content, (Column 7, lines 26-67; Column 9, lines 21-34) wherein the license component is incorporated within a component of the digital content (Column 7, lines 8-26; Figure 9A)

Rose ('709) does not explicitly disclose downloading, by a digital-content-accessing component executing on a computing device, one or more components of the digital content; authenticating, by the digital-content-accessing component executing on the computing device, the one or more components of the digital content; storing, by the digital-content-accessing component executing on the computing device, the one or more components in an unusable form in a memory; Coley et al. ('664) discloses downloading, by a digital-content-accessing component executing on a computing device, one or more components of the digital content; authenticating, by the digital-content-accessing component executing on the computing device, the one or more components of the digital content; storing, by the digital-content-accessing component executing on the computing device, the one or more components in an unusable form in a memory; (Figure 2; Column 4, lines 41-48; column 9, lines 1-23; column 9, lines 42-51). It would be obvious to one

having ordinary skill in the art at the time the invention was made to combine the Rose ('709)'s teaching with the Coley et al. ('664) method in order to enable secure licensing of a digital product.

12. As per claims 86, 100, 129,133 and 136

Rose ('709) discloses The method of claim 85, further comprising: executing, by the digital-content-accessing component executing on the computing device, a selection interface obtained from a digital content supplier, including:
invoking the selection interface; providing the digital content supplier computer system with a description of the digital content; and receiving the digital content from a remote digital-content vendor. (Figure 2, Column 3, lines 35-47)

13. As per claim 87, 101

Rose ('709) discloses the method of claim 86,
wherein the selection interface includes at least one of: an executable file configured to display a graphical user interface; data received by the computing device that enables display of the graphical user interface; a web page displayed on the computing device by a browser application; and a text file stored on the computing device that includes links or references to the digital content that enable access of the digital content by at least one or more of: an Internet browser, email, mail, telephone, fax, and a file transfer protocol application. (Column 3, lines 11-27; Column 4, lines 10-23; Figure 2)

14. As per claim 88, 102, 116, 125, 130 and 137

15. Rose ('709) discloses the method of claim 85, wherein the digital-content-accessing component is an executable file configured to download the components of the digital content from remote computer systems. (Column 7, lines 1-26).

16. As per claim 89, 103, 117, 126

Rose ('709) discloses the method of claim 88, further comprising:

receiving, at the computing device, the digital-content-accessing component from a remote computer. (Column 6, lines 40-44).

17. As per claim 90, 104, 118, 127 and 138

Rose ('709) discloses the method of claim 88, further comprising:

generating, by the computing device, the digital-content-accessing component from a component list. (Column 6, lines 28-39).

18. As per claims 91, 105 and 139

Rose ('709) discloses the method of claim 85, wherein authenticating the one or more downloaded components includes:

generating a message digest from the digital content; and comparing the generated message digest with a stored message digest. (Column 10, lines 30-42).

19. As per claim 92, 106, 119

Rose ('709) discloses the method of claim 85,

wherein at least one component of the digital content is encrypted. (Column 5, lines 8-12; 44-52).

20. As per claim 93, 107, 114 and 140

Rose ('709) discloses the method of claim 85, further comprising:

requesting, by the license component executing on the computing device,

an electronic license certificate from the remote licensing broker. (Column 7, lines 9-26; Column 9, lines 21-34).

21. As per claim 94, 108 and 141

Rose ('709) discloses the method of claim 93, further comprising:

receiving, by the license component executing on the computing device,

the electronic license certificate from the remote licensing broker; and

decrypting, by the license component executing on the computing device, encrypted digital content. (Column 10, lines 4-29).

As per claim 95, 109, 115, 124 and 142

Rose ('709) discloses method of claim 85,

Rose ('709) does not explicitly disclose executing, by the license component executing on the computing device, a purchase transaction including a purchase of a license for the digital content. Coley et al. ('664) discloses executing, by the license component executing on the computing device, a purchase transaction including a purchase of a license for the

digital content (Column 10, lines 6-27). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rose ('709)'s teaching with the Coley et al. ('664) method in order to enable the transaction to yield a useful product.

22. As per claims 96, 111 and 121 Rose ('709) discloses the method of claim 85, wherein the digital content includes one or more of:
digitally encoded executable code; digitally encoded source code; a digitally encoded video program; a digitally encoded audio program; digitally encoded music;
a digitally encoded game; a digitally encoded multi-media program; a digitally encoded movie; and a digitally encoded text document.(Column 1, lines 13-19).

23. As per claims 97, 110, 120
Rose ('709) discloses the method of claim 85, wherein the digital content includes one or more of: an encrypted executable file; an encrypted data file;a user interface library; a purchasing request library; a security information file; and an electronic license certificate. (Column 10, lines 21-53)

As per claims 98, 112, 134 and 143,
Rose ('709) discloses the method of claim 85,
Rose ('709) does not explicitly disclose receiving, by the license component executing on the computing device, the license certificate; and generating, by the license component executing on the computing device, a useable form of the digital content from the one or more components of the digital content according to the license certificate; Coley et al.

('664) discloses receiving, by the license component executing on the computing device, the license certificate; and generating, by the license component executing on the computing device, a useable form of the digital content from the one or more components of the digital content according to the license certificate; (Figure 2; Column 4, lines 41-48; column 9, lines 1-23; column 9, lines 42-51). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rose ('709)'s teaching with the Coley et al. ('664) method in order to enable the transaction to yield a useful product.

As per claims 114 and 123,

Rose ('709) discloses the method of claim 113,

wherein the incorporated license component is further configured to provide the license information as a request for an electronic licensing certificate that enables the licensing of the digital content.(Column 7, lines 9-26; Column 9, lines 21-34)

As per claim 131,

Rose ('709) discloses the method of claim 128, wherein the digital content vendor is a remote digital content vendor. (Figure 9A; Column 3, lines 35-47).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
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